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THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RUSSELL F. MIZELL

REMAILED

Appeal No. 2000-0300
Application No. 08/654,600

JULY 24,
JAN 31 2001

HEARD: January 23, 2001

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before CALVERT, ABRAMS, and GONZALES, Administrative Patent Judges.

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 3, 4, 6 and 8 through 13. Claims 5 and 7 have

Appeal No. 2000-0300
Application No. 08/654,600

been objected to as depending from a non-allowed claim. Claims 1 and 2 have been canceled.¹

We REVERSE and REMAND the application to the examiner for further consideration.

The appealed claims are directed to an apparatus for capturing target insect species. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Ruddell	1,787,421	Dec. 30, 1930
Brown	2,715,295	Aug. 16, 1955

Claims 3, 4, 6 and 8 through 13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Ruddell in view of Brown.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection (Paper No. 19) and the answer (Paper No. 25) for the examiner's complete reasoning in support of the rejection and to the main and reply briefs (Paper Nos. 24 and 27, respectively) for the appellant's arguments thereagainst.

¹ While the examiner has approved entry of the amendment after final rejection (Paper No. 20, filed February 12, 1999), we note that this amendment has not been clerically entered.

Appeal No. 2000-0300
Application No. 08/654,600

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We begin by observing that in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met does the burden of coming forward with either evidence or argument shift to the applicant. Id. If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Turning now to the subject matter set forth in the appealed claims, independent claim 13 calls for an apparatus for capturing target insect species comprising stinkbugs comprising: (1) a bottom portion for attracting the target insect species comprising at least a first and a second fin extending radially outwardly from a common longitudinal axis defined by a line of intersection of first

Appeal No. 2000-0300
Application No. 08/654,600

and second substantially vertical planes and defining opposed channel surfaces, each fin being wider at a base portion and narrower at a top portion and (2) a top portion for the capture of the target insect species comprising a receptacle being open only at an entrance opening and the entrance opening is positioned at and substantially surrounding an upper part of the bottom portion whereby the channel formed by the fins terminates within the receptacle. Claim 13 also requires that the bottom portion be predominantly of a color which reflects light having a wavelength which attracts the target insect species.

To support the rejection of claims 3, 4, 6 and 8 through 13 under 35 U.S.C. § 103, the examiner cites Ruddell and Brown. Ruddell discloses a beetle trap. As seen in Figures 1 and 2, Ruddell's trap, which is intended to be placed upon a support or suspended from above, includes a confining chamber or beetle container 1 and a bait holder or receptacle 2 adapted to be set in place upon and firmly but releasably secured to the container 1. In order for beetles to enter the container 1, Ruddell provides a funnel-shaped conduit 24 having a wide, upper portion that completely fills the mouth of the bait receptacle 2 and a narrow, lower portion including an aperture opening into the container 1. Disposed in the wide, upper portion of the conduit 24 is a baffle

30 comprised of metal plates or arms 31 and supported with its upper portion projecting above the open end of the conduit 24. Ruddell explains that beetles attracted to the trap by the bait and color of the trap² will strike the baffle 30, become dazed and drop into the container 1 via conduit 24 where they will be asphyxiated by the fumes of the bait. See p. 2, l. 120 through p. 3, l. 3.

Brown discloses a fly trap intended to be suspended from a supporting wire 21. The trap includes a transparent container 1 having an upper open end or neck 2, an opaque sleeve or duct member 4 having a lower end connected to the upper open end of the container, an opaque light shield 18 disposed above the upper open end of the duct member and a series of radially opaque fins 9 to divide the duct member into several passages. According to Brown, flies always seek escape at points of greater light intensity. See col. 7, ll. 22-24. Thus, flies which are attracted to the trap by the liquid lure in container 1 will enter the trap by way of the opaque duct member 4 and will be attracted to the sides of the container by the light passing through the container walls. When drawn to the walls of the container, the flies will contact the liquid insecticide and eventually die. See col. 5, ll. 1-13.

² As indicated in Fig. 1 of the reference, the bait holder 2 is white and the container 1 is green.

Appeal No. 2000-0300
Application No. 08/654,600

Since claim 13 requires a "top portion . . . comprising a receptacle, said receptacle being open only at an entrance opening" and Ruddell's container 1 includes an entrance opening 9 as well as ventilating openings 4, 5, Brown is applied for its teaching of a container or receptacle 1 being open only at an entrance opening 2. See final rejection, pp. 2 and 3. With regard to claim 13, the examiner acknowledges (id. at p. 2) that in order to read the claim on Ruddell, one would have to invert the trap disclosed by Ruddell.

The appellant cites In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) and argues that if Ruddell's apparatus were turned upside down, it would be inoperable for its intended purpose and, therefore, no motivation would have existed at the time of the appellant's invention to invert Ruddell's apparatus. See brief, pp. 10 and 11. We agree.

As indicated by our reviewing court in Gordon, the mere fact that Ruddell's apparatus could be oriented in an upside down orientation would not have made the modification obvious unless the prior art suggested the desirability of doing so. That is to say, there should be something in the prior art or a convincing line of reasoning in the answer suggesting the desirability of inverting the apparatus taught by Ruddell and modifying that apparatus in

Appeal No. 2000-0300
Application No. 08/654,600

such manner as to arrive at the claimed invention. In re Deminski, 796 F.2d 436, 443, 230 USPQ 313, 316 (Fed. Cir. 1986).

Reviewing the final rejection and the answer, we note that the examiner fails to identify anything in the art suggesting the desirability of inverting the apparatus of Ruddell. In our view, the only suggestion for inverting the apparatus of Ruddell as proposed by the examiner to meet the limitations of claim 13, stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

It follows that we cannot sustain the examiner's rejection of claim 13 or of claims 3, 4, 6 and 8 through 12, dependent thereon.

REMAND TO THE EXAMINER

We remand this application to the examiner to further consider the patentability of the claimed subject matter in view of the teachings, considered alone and in combination with other known relevant prior art, contained in the following reference:

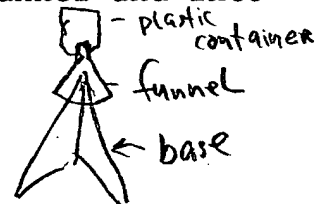
Appeal No. 2000-0300
Application No. 08/654,600

W.L. Tedders and W.B. Wood, "A new technique for monitoring pecan weevil emergence (Coleoptera: Curculionidae)," 29 J. Entomol. Sci., 18-30 (1994) (hereinafter "Tedders")³

On page 19 of this reference, Tedders describes a trap design used in a 1990 test comprising a bottom portion or base constructed of plywood and consisting of two triangular pieces, each measuring 55 cm at the base x 122 cm in height. The two pieces were bisected in the manner illustrated in the appellant's Fig. 1(a) and interlocked to form a free-standing pyramidal trap base. The base was painted either brown or white. In use, Tedders states that the base was anchored to the ground with two large gutter nails and a hook. Tedders also discloses a top portion comprising a 2-liter cylindrical plastic container and a screen funnel nestled into and fixed to the mouth of the plastic container to form the trap.

Tedders teaches that

[t]he trap, with funnel side down, was then placed on top of the pyramidal base so that weevils entering the screen funnel from below would crawl through the funnel and into the container and become trapped. (Page 19)



³ This reference was cited by the appellant in the information disclosure statement filed June 28, 1996 (Paper No. 4). The reference is also cited at p. 2 of the specification and discussed at p. 13-16.

Appeal No. 2000-0300
Application No. 08/654,600

At page 20, Tedders describes a 1991 test using apparatus of different heights. In this test, tall bases were constructed of masonite and consisted of two triangular pieces, each measuring 53.3 cm at the base x 121.8 cm in height (Fig. 1). The short bases were pentagonal-shaped and constructed from two masonite pieces measuring 61 cm at the base x 91.4 cm in height (Fig. 2). As a top portion, Tedders describes a modified boll weevil collecting trap top having a screen cone and collecting cylinder (with cap).

As a result of the 1990 and 1991 tests, Tedders concluded that brown traps were more attractive to the target species than white traps and that tall traps captured significantly more of the target species than short traps. See pp. 23 and 24.⁴

The language "apparatus for capturing target insect species comprising stinkbugs" found in the preamble of claim 13 does not

⁴ In view of the teachings in Tedders and other relevant prior art, the examiner should determine if one of ordinary skill in this art would have been instructed that the color and height of an insect trap is a result effective variable with respect to obtaining a trap which is capable of attracting a target insect species and thus the determination of the most effective color and height by routine experimentation was within the ordinary skill in this art. See, e.g., In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Appeal No. 2000-0300
Application No. 08/654,600

exclude additional, unrecited target insect species.⁵ Indeed, at the oral hearing held on January 23, 2001, the appellant's counsel acknowledged that the language "apparatus for capturing target insect species comprising stinkbugs" in conjunction with the language "said bottom portion being predominantly of a color which reflects light having a wavelength which attracts the target insect species" simply requires that the apparatus be capable of capturing some stinkbugs. We also call attention to the appellant's admission found in an article published in 1996 that stinkbugs comprised 4% of the insect species captured by "the standard dark Tedders trap."⁶ One could reasonably conclude from this admission that the brown trap described in Tedders also attracts stinkbugs.

The Mizell and Tedders article (see footnote 6) states that "[a] trap was developed for monitoring stink bugs and leaffooted bugs that was a modification of a pyramidal trap (Tedders and Wood

⁵ See Moleculon Research Corp. v. CBS, Inc., 793 F.2d 1261, 1271, 229 USPQ 805, 812 (Fed. Cir. 1986) (The term "comprising" denotes a patent claim as being "open," meaning that the recitation of structure in the claim is open to additional structural elements not explicitly mentioned.); In re Baxter, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); Ex parte Davis, 80 USPQ 448, 450 (Bd. App. 1948).

⁶ R.F. Mizell and W.L. Tedders, "A new monitoring method for detection of the stinkbug complex in pecan orchards" from Proceeding of the Southeastern Pecan Growers Association, pp. 36-41, particularly p. 38 (June 1, 1996), cited by the appellant in the information disclosure statement filed June 28, 1996.

1994) . . . [t]rap color and the top collection device were modified: the color being changed to bright yellow and the top was made of screen cloth and enlarged." See p. 36. Thus, one could reasonably conclude that the appellant is familiar with the details of the top portions of the Tedders traps used in the 1990 and 1991 tests. We consider the details of the top portions of the Tedders traps used in the 1990 and 1991 tests to be important information in determining the patentability of claim 13 and we strongly recommend that the appellant supplement the record by identifying the exact differences between the top portion as defined in appealed claim 13 and each of (a) the 2-liter cylindrical plastic container and screen funnel top trap of the Tedders 1990 test apparatus and (b) the modified boll weevil collecting trap top having a screen cone and collecting cylinder (with cap) of the Tedders 1991 test apparatus. See 37 CFR § 1.56.⁷

⁷ 37 CFR § 1.56(a) reads, in part, as follows:

A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section.

Appeal No. 2000-0300
Application No. 08/654,600

SUMMARY

The decision of the examiner to reject claims 3, 4, 6 and 8 through 13 under 35 U.S.C. § 103 is reversed.

Additionally, we have remanded the application to the examiner for consideration of additional issues.


REVERSED AND REMANDED

Jan A Calvert
JAN A. CALVERT

IAN A. CALVERT
Administrative Patent Judge



NEAL E. ABRAMS
Administrative Patent Judge


JOHN F. GONZALES
Administrative Patent Judge

JOHN F. GONZALES
Administrative Patent Judge

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Appeal No. 2000-0300
Application No. 08/654,600

KERKAM STOWELL KONDRACKI AND CLARKE
TWO SKYLINE PLACE
SUITE 600
5203 LEESBURG PIKE
FALLS CHURCH VA 22041-3401